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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,340	01/30/2004	Bryan R. Goring	T8467901US	5223
26912 7590 12/23/2008 GOWLING LAFLEUR HENDERSON LLP SUITE 1600, 1 FIRST CANADIAN PLACE 100 KING STREET WEST TORONTO, ON M5X 1G5 CANADA				
EXAMINER				
DAO, THUY CHAN				
ART UNIT		PAPER NUMBER		
2192				
MAIL DATE		DELIVERY MODE		
12/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,340

Applicant(s)

GORING ET AL.

Examiner

Thuy Dao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 12/23/05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the application filed on January 30, 2004.
2. Claims 1-42 have been examined.

Claim Objections

3. Claim 1 is objected to because of minor informalities. Acronym "API" should be spelled out at the first appearance in claims.

In line 7, the phrase is considered to read as - provisioning [[API]] Application Program Interface (API) set for provisioning ...- as disclosed in the specification, page 5, line 17.

4. Claims 21-40 direct to "A/The terminal...". In light of the specification, page 1, lines 9-11 (terminals such as "personal computers, self service kiosks...") and page 9, lines 7-15, the examiner treats "A/The terminal..." to be read as follows:

Claim 21:

The phrase in line 1 is considered to read as - A terminal, including a computer processor and a computer readable storage medium, for providing ...--.

Appropriate correction is requested.

Claim Rejections – 35 USC §102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-8, 10-28, and 30-42 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication No. 2004/0261086 A1 to Jensen et al. (hereafter "Jensen").

Claim 1:

Jensen discloses *a method for providing customized provisioning of an application program on a runtime environment of a terminal* (e.g., FIG. 2, provisioning applications/services from Provisioning Application 208 and Database 220, and deploying/installing provisioned applications/services on target devices 202a-c, [0014]-[0015], [0024]-[0030]),

the application including application content (e.g., Provisioning Application 208 and Database 220 includes a plurality of contents, [0025], [0033]-[0035]),

having at least one specified content type (e.g., target devices/user profiles, price/service plans, [0027]-[0033], [0037]-[0042]), *the method comprising the steps of:*

obtaining the application content by the runtime environment (e.g., FIG. 2, runtime environment of Provisioning Server 204, [0024]-[0027], [0031]-[0033]);

obtaining by the runtime environment a set of provisioning instructions related to the application content, the provisioning instructions coupled to the application for specifying a provisioning Application Program Interface (API) set for provisioning the application content (e.g., FIG. 3, Provisioning Server 204 specifying either Discovery, Subscription, or Delivery Provisioning API set, [0028]-[0031], [0036]-[0039], [0041]-[0043]); *and*

executing by the runtime environment the provisioning instructions for employing the API set to provision the application according to the specified content type (e.g., FIG. 2, provisioning applications/services according to target devices/user profiles/price plans, [0014]-[0015], [0043]-[0047], [0050]-[0053]).

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Claim 2:

Jensen discloses *the method according to claim 1, wherein provisioning control of the application content is shared between the runtime environment and the application through the coupled provisioning instructions (e.g., [0025], [0033]-[0035]).*

Claim 3:

Jensen discloses *the method according to claim 2 further comprising the step of employing a provisioning service to direct the provisioning API, the service configured for recognising the provisioning instructions (e.g., [0014]-[0015], [0024]-[0030]).*

Claim 4:

Jensen discloses *the method according to claim 3 further comprising the step of the service customizing the provisioning process and the associated provisioning API set according to the provisioning instructions (e.g., [0024]-[0027], [0031]-[0033]).*

Claim 5:

Jensen discloses *the method according to claim 4, wherein the service is shared by a plurality of the applications (e.g., [0028]-[0031], [0036]-[0039], [0041]-[0043]).*

Claim 6:

Jensen discloses *the method according to claim 3 further comprising the step of employing a standard one of the provisioning API set by the service (e.g., [0026]-[0030], [0040]-[0042]).*

Claim 7:

Jensen discloses *the method according to claim 6 further comprising the step of obtaining remotely a custom API via a network coupled to the terminal* (e.g., [0031]-[0034], [0043]-[0046]).

Claim 8:

Jensen discloses *the method according to claim 2, wherein the provisioning instructions are selected from the group comprising code, script, and configuration data* (e.g., [0027]-[0033], [0037]-[0042]).

Claim 10:

Jensen discloses *the method according to claim 8, wherein the provisioning instructions are separate from the application content* (e.g., [0014]-[0015], [0024]-[0030]).

Claim 11:

Jensen discloses *the method according to claim 10 further comprising the step of accessing the provisioning instructions remotely from the terminal* (e.g., [0014]-[0015], [0043]-[0047], [0050]-[0053]).

Claim 12:

Jensen discloses *the method according to claim 11, wherein the remote access of the provisioning instructions is in conjunction with a networked repository* (e.g., [0025], [0033]-[0035]).

Claim 13:

Jensen discloses *the method according to claim 12, wherein the terminal is selected from the group comprising wired devices and wireless devices* (e.g., [0027]-[0033], [0037]-[0042]).

Claim 14:

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Jensen discloses *the method according to claim 5, wherein a generic API is included in the provisioning API set, the generic API configured for addressing by at least two dissimilar ones of the specified content type (e.g., [0026]-[0030], [0040]-[0042]).*

Claim 15:

Jensen discloses *the method according to claim 14 further comprising the step of employing a series of enablers for providing access to corresponding selected ones of the generic API, each of the enablers associated with a predefined content type (e.g., [0024]-[0027], [0040]-[0042], [0047]-[0050]).*

Claim 16:

Jensen discloses *the method according to claim 2, wherein a generic API is included in the provisioning API set, the generic API configured for addressing by at least two dissimilar ones of the specified content type (e.g., [0031]-[0034], [0043]-[0046]).*

Claim 17:

Jensen discloses *the method according to claim 16 further comprising the step of employing a series of enablers for providing access to corresponding selected ones of the generic API, each of the enablers associated with a predefined content type (e.g., [0027]-[0033], [0041]-[0043]).*

Claim 18:

Jensen discloses *the method according to claim 17, wherein the enabler is an executable unit that executes provisioning instruction requests for the predefined content type (e.g., [0028]-[0031], [0036]-[0039], [0041]-[0043]).*

Claim 19:

Jensen discloses *the method according to claim 18 further comprising the step of obtaining the enabler selected from the group comprising: locally on the terminal by a provisioning service (e.g., [0025], [0033]-[0035]);*

bundled with a content descriptor of the application content; and remotely from the terminal by the provisioning service (e.g., [0024]-[0027], [0031]-[0033]).

Claim 20:

Jensen discloses *the method according to claim 5, wherein the provisioning instructions were amended prior to the step of obtaining the provisioning instructions by the runtime environment (e.g., [0014]-[0015], [0024]-[0030]).*

Claim 21:

Jensen discloses *a terminal for providing customized provisioning of an application program on a runtime environment (e.g., FIG. 2, provisioning applications/services from Provisioning Application 208 and Database 220, and deploying/installing provisioned applications/services on target devices 202a-c, [0014]-[0015], [0024]-[0030]),*

the application including application content (e.g., Provisioning Application 208 and Database 220 includes a plurality of contents, [0025], [0033]-[0035])

having at least one specified content type (e.g., target devices/user profiles, price/service plans, [0027]-[0033], [0037]-[0042]), the terminal comprising:

a processing framework for obtaining the application content (e.g., FIG. 2, runtime environment of Provisioning Server 204, [0024]-[0027], [0031]-[0033]);

a provisioning API set included in the processing framework for provisioning the application content (e.g., FIG. 3, Provisioning Server 204

specifying either Discovery, Subscription, or Delivery Provisioning API set, [0028]-[0031], [0036]-[0039], [0041]-[0043]); and

a set of provisioning instructions related to the application content, the provisioning instructions coupled to the application for specifying selected ones of the provisioning API set (e.g., FIG. 2, provisioning applications/services according to target devices/user profiles/price plans, [0014]-[0015], [0043]-[0047], [0050]-[0053]).

Claim 22:

Jensen discloses the terminal according to claim 21, wherein provisioning control of the application content is shared between the framework and the application through the coupled provisioning instructions (e.g., [0027]-[0033], [0037]-[0042]).

Claim 23:

Jensen discloses the terminal according to claim 22 further comprising a provisioning service to direct the provisioning API, the service configured for recognising the provisioning instructions (e.g., [0028]-[0031], [0036]-[0039], [0041]-[0043]).

Claim 24:

Jensen discloses the terminal according to claim 23 wherein the service is configured for customizing the provisioning process and the associated provisioning API set according to the provisioning instructions (e.g., [0014]-[0015], [0024]-[0030]).

Claim 25:

Jensen discloses the terminal according to claim 24, wherein the service is shared by a plurality of the applications (e.g., [0014]-[0015], [0043]-[0047], [0050]-[0053]).

Claim 26:

Jensen discloses *the terminal according to claim 23, wherein the service employs a standard one of the provisioning API set (e.g., [0025], [0033]-[0035]);*

Claim 27:

Jensen discloses *the terminal according to claim 26, a custom API is obtained remotely by the service via a network coupled to the terminal (e.g., [0024]-[0027], [0031]-[0033]).*

Claim 28:

Jensen discloses *the terminal according to claim 22, wherein the provisioning instructions are selected from the group comprising code, script, and configuration data (e.g., [0026]-[0030], [0040]-[0042]).*

Claim 30:

Jensen discloses *the terminal according to claim 28, wherein the provisioning instructions are separate from the application content (e.g., [0024]-[0027], [0040]-[0042], [0047]-[0050]).*

Claim 31:

Jensen discloses *the terminal according to claim 30, wherein the provisioning instructions are configured for obtaining the remotely from the terminal (e.g., [0031]-[0034], [0043]-[0046]).*

Claim 32:

Jensen discloses *the terminal according to claim 31, wherein the remote access of the provisioning instructions is in conjunction with a networked repository (e.g., [0014]-[0015], [0033]-[0035]).*

Claim 33:

Jensen discloses *the terminal according to claim 32, wherein the terminal is selected from the group comprising wired devices and wireless devices* (e.g., [0027]-[0033], [0041]-[0043]).

Claim 34:

Jensen discloses *the terminal according to claim 25, wherein a generic API is included in the provisioning API set, the generic API configured for addressing by at least two dissimilar ones of the specified content type* (e.g., [0026]-[0030], [0040]-[0043]).

Claim 35:

Jensen discloses *the terminal according to claim 34 further comprising a series of enablers for providing access to corresponding selected ones of the generic API, each of the enablers associated with a predefined content type* (e.g., [0014]-[0015], [0043]-[0047], [0050]-[0053]).

Claim 36:

Jensen discloses *the terminal according to claim 22, wherein a generic API is included in the provisioning API set, the generic API configured for addressing by at least two dissimilar ones of the specified content type* (e.g., [0014]-[0015], [0024]-[0030]).

Claim 37:

Jensen discloses *the terminal according to claim 36 further comprising a series of enablers for providing access to corresponding selected ones of the generic API, each of the enablers associated with a predefined content type* (e.g., [0027]-[0033], [0037]-[0042]).

Claim 38:

Jensen discloses *the terminal according to claim 37, wherein the enabler is an executable unit that executes provisioning instruction requests for the predefined content type* (e.g., [0024]-[0027], [0031]-[0033]).

Claim 39:

Jensen discloses *the terminal according to claim 38, wherein the enabler location is selected from the group comprising: locally on the terminal by a provisioning service* (e.g., [0028]-[0031], [0036]-[0039], [0041]-[0043]);

bundled with a content descriptor of the application content; and remotely from the terminal by the provisioning service (e.g., [0025], [0033]-[0035]).

Claim 40:

Jensen discloses *the terminal according to claim 25, wherein the provisioning instructions were amended prior to the step of obtaining the provisioning instructions by the runtime environment* (e.g., [0026]-[0030], [0040]-[0042]).

Claim 41:

Jensen discloses *a method for providing customized provisioning of an application program on a runtime environment of a terminal* (e.g., FIG. 2, provisioning applications/services from Provisioning Application 208 and Database 220, and deploying/installing provisioned applications/services on target devices 202a-c, [0014]-[0015], [0024]-[0030]),

the application including application content (e.g., Provisioning Application 208 and Database 220 includes a plurality of contents, [0025], [0033]-[0035])

having at least one specified content type (e.g., target devices/user profiles, price/service plans, [0027]-[0033], [0037]-[0042]), *the method comprising the steps of:*

sending the application content for receipt by the runtime environment (e.g., FIG. 2, runtime environment of Provisioning Server 204, [0024]-[0027], [0031]-[0033]);

sending a set of provisioning instructions related to the application content for receipt by the runtime environment, the provisioning instructions coupled to the application for specifying a provisioning API set for provisioning the application content (e.g., FIG. 3, Provisioning Server 204 specifying either Discovery, Subscription, or Delivery Provisioning API set, [0028]-[0031], [0036]-[0039], [0041]-[0043]); and

making available selected ones of the API provisioning set for use by the provisioning instructions; wherein execution of the provisioning instructions employs the API provisioning set to provision the application according to the specified content type (e.g., FIG. 2, provisioning applications/services according to target devices/user profiles/price plans, [0014]-[0015], [0043]-[0047], [0050]-[0053]).

Claim 42:

Jensen discloses a computer program product for providing customized provisioning of an application program on a runtime environment of a terminal (e.g., FIG. 2, provisioning applications/services from Provisioning Application 208 and Database 220, and deploying/installing provisioned applications/services on target devices 202a-c, [0014]-[0015], [0024]-[0030]),

the application including application content (e.g., Provisioning Application 208 and Database 220 includes a plurality of contents, [0025], [0033]-[0035])

having at least one specified content type (e.g., target devices/user profiles, price/service plans, [0027]-[0033], [0037]-[0042]), the computer program product comprising:

a computer readable medium; a processing framework module stored on the computer readable medium for obtaining the application content

(e.g., FIG. 2, runtime environment of Provisioning Server 204, [0024]-[0027], [0031]-[0033]);

a provisioning module coupled to the framework module, the provisioning module configured for utilising a provisioning API set for provisioning the application content (e.g., FIG. 3, Provisioning Server 204 specifying either Discovery, Subscription, or Delivery Provisioning API set, [0028]-[0031], [0036]-[0039], [0041]-[0043]); and

an interpreter module coupled to the framework module, the interpreter module configured for executing a set of provisioning instructions related to the application content (e.g., FIG. 2, provisioning applications/services according to target devices/user profiles/price plans, [0014]-[0015], [0043]-[0047], [0050]-[0053]),

the provisioning instructions associated with the application for specifying selected ones of the provisioning API set (e.g., FIG. 3, Provisioning Server 204 specifying either Discovery, Subscription, or Delivery Provisioning API set, [0028]-[0031], [0036]-[0039], [0041]-[0043]).

Claim Rejections – 35 USC §103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of US Patent Publication No. 2002/0131404 A1 to Mehta et al. (hereafter "Mehta").

Claim 9:

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Jensen does not explicitly disclose *the method according to claim 8, wherein the provisioning instructions are embedded in the application content.*

However, in an analogous art, Mehta further discloses *the provisioning instructions are embedded in the application content* (e.g., [0015], [0010]-[0011], [0064]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Mehta's teaching into Jensen's teaching. One would have been motivated to do so to embed provisioning code such as instrumenting code into application content for billing purpose as suggested by Mehta (e.g., [0010]-[0011]).

Claim 29:

Claim 29, which recite(s) the same limitations as those of claim 9, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the reference teaches all of the limitations of the above claim(s), it also teaches all of the limitations of claim 29.

Conclusion

9. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status

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information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Thuy Dao/

Examiner, Art Unit 2192

/Tuan Q. Dam/

Supervisory Patent Examiner, Art Unit 2192